

### **REMARKS**

This is in response to the Office Action of December 18, 2002. This amendment is accompanied by a request for a one month extension of time and the requisite fee. Therefore, this amendment is timely filed.

### **Status of the Application**

Claims 1-63 were initially presented. In the Office Action of December 18, 2002, the Examiner rejected claims 1-12, 14-49, and 51-63, and objected to claims 13 and 50. By way of this amendment, Applicants cancel claims 1-37, 40, and 51-63, amend claims 38-39 and 41-50, and add new claims 64-105. Accordingly, claims 38-39, 41-50, and 64-105 are now pending in the above identified patent application.

In view of above amendments and the following remarks, reconsideration of the application is respectfully requested.

### **The Specification**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification of a patent into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

The original "BRIEF SUMMARY OF THE INVENTION" section of the specification has been replaced with a new summary section that is consistent with the new claims pursuant to 37 C.F.R. § 1.73, which states that "Such summary should, when set forth, be commensurate with the invention as claimed..."

#### **Claim Amendments**

In claims 38-39 and 41-50, the claims have been made amended to change "game of chance" to --individual game--, "earmarking" to --designating--, "earmarkable" to --capable of being designated--, and "said" to --the--. Applicant respectfully submits that these amendments are not narrowing amendments and have not been made for reasons of patentability.

#### **The Claim Objections**

The Examiner objected to claims 33 and 34. These claims have been canceled, and thus Applicant respectfully submits that the objections are moot.

#### **The Rejections Under 35 U.S.C. §112**

Claims 4, 14-37, 42, and 51-63 were rejected under 35 U.S.C. §112, 2<sup>nd</sup>, as allegedly being indefinite. Claims 4, 14-37, and 51-63 were canceled, and thus Applicant respectfully submits that the rejection of these claims are moot. Claim 42 has been amended to delete "said plurality." In light of this amendment, Applicant respectfully submits that the rejection of claim 42 is moot.

#### **The Rejections Under 35 U.S.C. §103**

Claims 1-12, 14-36, 38-49, 51-58, 62, and 63 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,312,332 to Walker et al. (Walker)

in view of U.S. Patent No. 5,938,200 to Markowicz et al. (Markowicz). Claims 59-61 were rejected under 35 U.S.C. §103 as being unpatentable over Walker in view of Markowicz and further in view of U.S. Patent No. 6,319,125 to Acres. (Acres).

A. Claim 38

1. No Motivation

To establish a prima facie case of obviousness, the prior art must provide a suggestion or motivation to combine or modify the references. *See MPEP* §2143.01. Even if the above-discussed element were taught or suggested by Markowicz (which is not admitted), the Office Action does not set forth a motivation to combine Walker with Markowicz.

The Office Action states "Markowicz's disclosed invention could be easily configured, utilizing functions and features of Walker's disclosed gaming invention to conform to the present claim limitations." *Office Action*, p. 5 (emphasis added). But merely because references can be combined or modified does not render the resultant combination obvious. *See MPEP* §2143.01.

The Office Action further states that "[o]ne would be motivated to combine the disclosures of Markowicz and Walker in order to visibly illustrate and facilitate game players following the progress of game." *Office Action*, p. 5. Walker, however, already describes a game display that visibly illustrates, and helps players to follow, the progress of the game. *See Walker* at Fig. 5. Thus, what the Office Action cites as a motivation is, in fact, not a motivation at all.

Moreover, Walker appears to describe a team game where players on the team cooperate to achieve a team bonus. *See Walker* at Abstract, col. 3, lines 13-16. If the team achieves a total number of bonus conditions, a bonus payout is awarded to all of the players on the team. *See Walker* at Abstract. On the other hand, Markowicz appears to describe individual players attempting to reach individual termination points. *See Markowicz* at Abstract. The display of Markowicz appears to show the individual progress of individual players toward individual termination points. *See Markowicz* at Fig. 2. Thus, one of ordinary skill in the art would not be motivated to combine the disclosures of Markowicz and Walker because they relate to different types of games: 1) a team game where players on the team cooperate to achieve a

team bonus; versus 2) a game in which individual players attempt to reach individual termination points.

Because the Office Action has not cited a motivation or suggestion in the prior art to combine Walker and Markowicz to arrive at the invention as recited in claim 38, the Examiner has not established a prima facie case of obviousness.

2. All Claim Elements Are Not Taught or Suggested

To establish a prima facie case of obviousness, the prior art references must teach or suggest all the claim limitations. *See MPEP* §2143.03. Even if the prior art provided a motivation or suggestion to combine Walker with Markowicz (which is not admitted), Walker and Markowicz do not teach, disclose, or suggest all the elements of claim 38.

For example, the applied references do not teach, disclose, or suggest "each cell in said at least one group of cells capable of being designated with a designator in response to any player of the plurality of players achieving the at least one specific outcome, wherein the designator indicates the gaming machine at which the at least one specific outcome was generated."

The Office Action states "Walker does not conspicuously configure the display of the video gaming machines to illustrate rows of cells that are defined by rungs and earmarkable by designators, which visibly show the progress of the game." *Office Action* at pp. 4-5. The Office Action then cites Markowicz as teaching "cells, rungs and designators responsive to at least one specific outcome resulting from at least one gaming machine." *Office Action* at p. 5.

Markowicz describes a game display having two grids of blocks in which each row or column of blocks corresponds to a player. *See Markowicz* at col. 3, line 62 to col. 4, line 12; Fig. 2. Therefore, each block of Markowicz corresponds to one and only one player. Markowicz does not teach anything about each block being capable of designation with a designator in response to any player achieving a specific outcome.

Because the applied references do not teach, disclose, or suggest the above element, among others, claim 38 is allowable.

B. Claims 41 and 42

Claims 41 and 42 depend from claim 38. Applicant respectfully submits that claims 41 and 42 are allowable for the same reasons as discussed with respect to claim 38.

Additionally, the Office Action states that "Walker discloses apportioning and distributing at least one payout among gaming machines ... according to a number of each of the unique identifiers." *Office Action*, p. 3. Applicant respectfully disagrees. Walker merely states "the bonus payouts may vary amongst the players, for example favoring one or more players who contribute the most to achieving the bonus conditions with a higher payout." *Walker*, col. 6, lines 49-52. It is not clear what this statement teaches other than providing a higher payout to the players who contribute the most. Accordingly, Applicant respectfully submits that this statement does not disclose the elements as recited in claims 41 and 42.

C. Other Claims

Claims 39 and 43-50 depend from claim 38. It is respectfully submitted that these claims are allowable for the same reasons discussed with respect to claim 38, and for other reasons.

Applicant respectfully submits that new claims 64-105 are allowable.

**Information Disclosure Statement**

Applicant also submits herewith an Information Disclosure Statement.

**Conclusion**

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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